

REMARKS

Claims 1-6 are all the claims pending in the application. Claims 1, 2 and 6 are being examined. Claim 2 is linking claim as defined in MPEP § 809.03. Rejoinder of process claims 3-5 is requested upon allowance of claims 1 and 6 and/or linking claim 2.

The specification is amended herein by incorporating the JIS Z 0237 standard mentioned in the specification at page 6, lines 21-23. No new matter is presented.

Entry of the above amendment is respectfully requested.

Claims 1-2 and 6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Examiner states that the JIS standard recited in the claims renders the claims indefinite.

Applicants respectfully traverse the rejection.

The Examiner's focus in determining whether the claims are definite in compliance with 35 U.S.C. § 112, second paragraph should be whether the claims set out the claimed subject matter with a reasonable degree of clarity and particularity in light of (1) the content of the specification; (2) the teachings of the prior art; and (3) the claim interpretation that would be given by one of ordinary skill in the art.

The primary purpose of the requirement for definiteness of claim language is to ensure that the scope of the claims is clear. A second purpose is to provide a clear measure of what Applicants regard as their invention so that it can be determined whether the claimed invention meets all the criteria of patentability. See MPEP § 2173.

One of ordinary skill in the art is familiar with the JIS standard recited in the present claims and described in the present specification. The JIS standard is readily available and provides a clear measure for determining ball tack as recited in the present claims.

Further, it is not uncommon for a US patent to issue with a JIS standard recited in the claims. A brief internet search of issued patents revealed over 2000 US patents which recite JIS standards in the claims. 50 US patents were recently issued between June 17, 2008 and January 13, 2009, which recite a JIS standard in the claims.

Thus, Applicants submit that the present claims are definite and one of ordinary skill in the art would readily be able to determine the meaning and scope of the claims in view of the recitation of the JIS standard in the present claims, the description in the specification and the knowledge and teachings in the prior art.

Applicants also submit a copy of the JIS Z 0237 standard (latest revision in 2000)¹ and a sworn English translation thereof. The specification is amended to include the standard and how the ball tack is determined and evaluated according to this standard. Thus, the specification provides a clear definition of the standard recited in the claims. This amendment is supported by the specification as filed, which specifically states that “ball tack” means values obtained by the ball rolling method as provided for in JIS Z 0237 at page 6, lines 21-23.

For the reasons set forth above, the claims are definite and one of ordinary skill in the art would be able to readily ascertain the meaning and scope of the claimed invention.

¹ Applicants note that the designation “Z 0237:2000” on the front page of the Standard indicates the latest revision in the year 2000.

Accordingly, Applicants respectfully request withdrawal of the §112, 2nd paragraph, rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

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CUSTOMER NUMBER

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/Jennifer M. Hayes/
Jennifer M. Hayes
Registration No. 40,641